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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,876	03/08/2001	Masahiro Kawano	96790P344	7983

7590 05/07/2004

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,876

Applicant(s)

KAWANO ET AL.

PS

Examiner

Stephen M Gravini

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20010308.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20010308.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3622

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Naqvi et al. (WO 97/21183). Naqvi is considered to disclose the claimed system comprising:

information receiving apparatus automatically accessing the advertising information sending apparatus at preset time to download through the Internet advertising information stored in the advertising information sending apparatus (page 2 line 9 through page 3 line 5 wherein the disclosed banner is considered patentably equivalent to the claimed automatic login and access to advertising information because the applicant's specification describes automatic presentation of advertising information when a user accesses a computer which performs the same function, in the same manner, with the same result as the disclose banner), and

on a monitor screen of the advertising information receiving apparatus, the advertising information downloaded by said automatic login means is displayed, together with a predetermined character, comprises automatic login means for in a balloon accompanying the character (page 5 lines 3-10 wherein the disclosed banner is considered to anticipate the claimed balloon because both perform the same function, in

Art Unit: 3622

the same manner, with the same result). Naqvi is also considered to disclose the claimed internet plurality of characters (page 15 lines 9-11), internet user related data with a preset transmission time (page 17 line 26 through page 18 line 28), monitor screen front side (page 19 line 9), moving image (page 19 line 20), display position change (page 19 line 30 through page 20 line 2), sequential access (page 20 line 13), changing settings (page 20 line 1), and information setting change (page 34 lines 21-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naqvi in view of Judson (US 5,737,619). Naqvi is considered to disclose the claimed invention as discussed above in the anticipatory rejection except for the claimed company URL page. Judson is considered to disclose the claimed company URL page at column 6

lines 29-41. It would have been obvious to one skilled in the art to combine the teachings of Judson with the teachings of Naqvi for the purpose of providing network computer users access to more company information than its presented banner advertisement through the use of a hyperlink within the presented advertisement.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naqvi in view of reference U, cited in this Office action. Naqvi is considered to disclose the claimed invention as discussed above in the anticipatory rejection except for the claimed questionnaire and fortune-telling data. Fortune-telling data is broadly construed to be interpreted as demographic data gathering for advertisement projection or advertisement targeting, which is considered reasonable in light of the applicant's specification under MPEP 2111. Reference U is considered to disclose the claimed questionnaire and fortune-telling data at the second page within the fifth full paragraph beginning with Users. It would have been obvious to one skilled in the art to combine the teachings of reference U with the teachings of reference U for the purpose of gathering demographic information, such as that used in a questionnaire, for predicting an advertisement targeting projection for a presented advertisement.


Art Unit: 3622

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barrett et al. (US 5,568,612) is considered to disclose the system of delivering information, which may include advertisements, to computer network users.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is steve.gravini@uspto.gov. Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
May 6, 2004